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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,782	08/16/2002	Gerald P. Piechowski	ITW7510.016	4082
33647	7590	04/23/2004	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (ITW)			EDMONDSON, LYNNE RENEE	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	

1725

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/064,782

Applicant(s)

PIECHOWSKI ET AL.

Examiner

Lynne Edmondson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-17 and 19-27 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Stol (USPN 4642445).

Stol teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas and thereby reducing contamination (smoke removal, claim 16, col 2 lines 1-4 and col 4 lines 24-32). This filter is used for welding devices, particularly arc welding (col 1 lines 5-13). The filter comprises a housing (333, col 4 lines 18-41) with a steel screening material (351 and 355, col 4 line 55 – col 5 line 18) retained in a passageway between inlets (343, 361 and 365) and outlets (363, 337 and 335) wherein inlets 361 and 343 and outlet 363 are capable of being attached to a gas cylinder and a variety of fittings (col 5 lines 29-63). The steel screen contains micropores which filter particles larger than 100 microns (200 mesh has openings of approximately 75 microns, col 4 lines 27-29). Figures 2 and 3 show the outwardly extending annular recess (skirt). See also Stol claims 1-5 and 8-20.

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3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Flynn et al. (USPN 5846271).

Flynn teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas comprising a housing (10), the housing having a threaded inlet (20) and outlet (26) which can be connected to anything (col 3 lines 42-65 and figure 2) and a stainless steel filter screen (col 4 lines 63-67).

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (USPN 5114447).

Davis teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas comprising a housing (18), the housing having a threaded inlet (12) and outlet (22) which can be connected to anything (col 3 lines 23-47 and figure 6) and a stainless steel filter screen (col 4 lines 23-30) which prevents passage of particles larger than 100 microns (col 4 lines 39-54).

5. Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sherwood, Jr. (US 2002/0046555 A1).

Sherwood teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas comprising a housing (22), the housing having an inlet (62) and an outlet (58) shaped and sized to match mating systems which can be anything (paragraphs 14 and 46 and figure 1) and

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a stainless steel filter screen (32, paragraphs 41-43). The screen is located in a recessed, tapered passageway as shown in figures 1 and 8 (paragraphs 39 and 40).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (USPN 2413991) in view of Offer et al. (USPN 5981897)

Newman teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas comprising a housing (40), the housing having an inlet (50) and an outlet (51) which can be connected to anything, a steel filter screen (col 2 lines 24-52 and figure 6). Male and female threading is present to facilitate connection other parts and devices (col 3 lines 10-18). However, there is no disclosure of female inlet threading and male outlet threading.

Offer teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas (col 2 lines 47-52 and col 10 lines 20-30), comprising a housing (104) with a screening material (114) which may be porous steel (col 6 lines 1-3 and lines 25-31) retained in a passageway between

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the inlet (98) and outlet (16) inlet and outlet are capable of being attached to a gas cylinder and a variety of fittings (figures 14A-14C and col 11 line 3 – col 12 line 7). The inlet comprises a female threaded fitting (for attachment to 104, figure 14B, col 11 lines 38-42). The outlet comprises a male threaded fitting (for connection to fitting 106, figure 14B and col 11 lines 38-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ male and female threads to engage external equipment as well as replace parts in a simple and economical manner (Newman, col 1 lines 11-26 and col 5 lines 24-28).

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (USPN 5114447).

Davis teaches a gas filter capable of preventing a shielding gas from introducing particles exceeding a predetermined size into undesired areas comprising a housing (18), the housing having a threaded inlet (12) and an outlet (22) which can be connected to anything (col 3 lines 23-47 and figure 6) and a stainless steel filter screen (col 4 lines 23-30) which prevents passage of particles larger than 100 microns (col 4 lines 39-54). However the particular threading at the inlet and outlet is not further disclosed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ male and female threads as needed to engage external equipment as well as replace parts in a simple and conventional manner.

***Response to Arguments***

9. Applicant's arguments with respect to claim 2 have been considered but are moot in view of the new ground(s) of rejection.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., connection to a solenoid valve, used for welding) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The outlets are capable of being connected to tanks and valves.

11. In response to applicant's argument that connecting the inlets outlets to tanks and valves would be impractical, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. The outlets are capable of being connected to tanks and valves. Therefore the 102 rejection of claims 1 and 3-5 as anticipated by Stol stands.

***Allowable Subject Matter***

13. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art teaches the invention essentially as claimed but does not teach the filter incorporated into a welding power source. See Stol where the power source is remote from the filter.

15. Claims 7-17 and 19-27 are allowed.

16. The following is an examiner's statement of reasons for allowance: The closest prior art teaches the invention essentially as claimed but does not teach a gas cylinder or solenoid valve. Neither is the filter incorporated into the welding power source. See Stol where the power source is remote from the filter.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."



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**Conclusion**

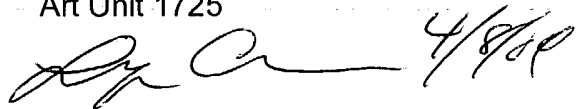
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newman (USPN 2413991, filter as claimed with steel screen), Williams (USPN 4746338, filter as claimed).and Dibacco et al. (USPN 5844201, welder, gas filter, inlet, outlet, gas hose, solenoid valve).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (571) 272-1172. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Lynne Edmondson  
Primary Examiner  
Art Unit 1725

A handwritten signature in black ink, appearing to read 'Lynne Edmondson', followed by the date '4/8/04'.

LRE  
April 8, 2004